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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/374,279	01/18/95	CHIU C	1477A-2

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EXAMINER	
HAILEY, P	
ART UNIT	PAPER NUMBER
1106	10

DATE MAILED: 07/03/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

A shortened statutory period for response to this action is set to expire three months(s), or thirty days, whichever is longer, from the date of this communication.

Office Action Summary	Application No. 08/374,279	Applicant(s) Chung-wai Chiu, et al.
	Examiner Hailey, Lynn	Group Art Unit 1106

☒ Responsive to communication(s) filed on *Apr 19, 1996* .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-34* is/are pending in the application.

Of the above, claim(s) *1-11 and 18-34* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *12-17* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *2*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Election/Restriction

1. Applicants' response to a restriction requirement filed on April 19, 1996, has been received. Applicants have elected Group II, claims 12, 16, and 17, drawn to a method of making a starch. However, Applicants have traversed the restriction between Groups II and III; it is agreed that a search for these groups would not be burdensome, therefore these Groups will be combined and examined as an elected Group.

2. Claims 1-11 and 18-34 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected starch, flour, and processes for making a flour, the requirement having been traversed in Paper No. 9.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Double Patenting

4. Claims 12-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending application Serial No.

08/473,688. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the '688 application fail to recite pH limitations.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6. Claims 12-17 are rejected under 35 U.S.C. § 103 as being unpatentable over Wurzburg, et al. (U.S. Patent No. 3,977,897), Applicants' admitted art.

The reference teaches the features described below. Wurzburg, et al. teach a process for preparing a non-chemically inhibited starch by controlled heating (at a specified pH of from about 3 to 9, see col. 3, lines 63-64) of a suspension comprising a starch in intact granule form and an inorganic salt at temperatures up to 100°C for a time up to 30 hours. See col. 4, lines 5-20 of Wurzburg, et al. Although this temperature range is lower than that claimed by Applicants, Wurzburg, et al. teach that "shorter heating periods may be used at higher temperatures" to provide a greater degree of inhibition. See col. 4, lines 12-

15 of Wurzburg, et al. From this teaching, it is deemed to have been obvious to one having ordinary skill in the art at the time the invention was made to have adjusted the temperature range and time length to read upon Applicants' claim limitations in order to provide a desired inhibited starch.

Following chemical inhibition, the starch is then recovered by conventional means, e.g., washing the treated starch product and then drying by known means such as air drying, belt drying, or flash or spray drying. See col. 4, lines 21-27 of Wurzburg, et al.

The difference between the Wurzburg, et al. reference and Applicants' claims are as follows:

a. Wurzburg, et al. fail to disclose the order of the operative steps recited in Applicants' claims 12 and 13 (Wurzburg, et al. heat treat the starch suspension, then dehydrate).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have reversed the heat treating and dehydrating steps of Wurzburg, et al., because it has been held that reversing the order of steps in a process does not impart patentability when no unexpected result is obtained. Ex parte Rubin (POBA 1959) 128 U.S.P.Q. 440, Cohn v. Comr. Pats. (DCDC 1966) 251 F Supp 378, 148 U.S.P.Q. 486.

b. Wurzburg, et al. also fail to employ a fluidized bed reactor to dehydrate and heat treat the starch, as recited in Applicants' claim 17.

As Wurzburg, et al. discloses that the drying step is performed by known means, such as air drying, belt drying, or flash or spray drying (see col. 4, lines 21-27 of Wurzburg, et al.), it would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected any known drying apparatus to dehydrate the starch product of Wurzburg, et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynn Hailey whose telephone number is (703) 308-3317. The examiner can normally be reached on Mondays through Thursdays from 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony McFarlane, can be reached on (703) 308-3806. The fax phone number for this Group is (703) 305-3599 or 305-3600.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Lynn Hailey/plh
July 2, 1996

ANTHONY MC FARLANE
PATENT EXAMINER
ART UNIT 116